Supreme Court, U.S.
FILED
JUL 22 2015
OFFICE OF THE CLERK

No. 15-866

IN THE

Supreme Court of the United States

STAR ATHLETICA, LL.C.,

Petitioner,

v.

VARSITY BRANDS, INC., ET AL.,

Respondents.

On Writ of Certiorari to the United States Court of Appeals for the Sixth Circuit

BRIEF OF PROFESSORS CHRISTOPHER BUCCAFUSCO AND JEANNE FROMER AS *AMICI CURIAE* IN SUPPORT OF PETITIONER

JEANNE C. FROMER
NEW YORK UNIVERSITY
SCHOOL OF LAW
40 Washington Square South
New York, NY 10012

CHRISTOPHER BUCCAFUSCO
BENJAMIN N. CARDOZO
SCHOOL OF LAW
YESHIVA UNIVERSITY
55 Fifth Avenue
New York, NY 10003

MEIR FEDER
Counsel of Record
MATTHEW J. SILVEIRA
JONES DAY
250 Vesey Street
New York, NY 10281
(212) 326-3939
mfeder@jonesday.com

Counsel for Amici Curiae

QUESTION PRESENTED

What is the appropriate test to determine when a feature of a useful article is protectable under § 101 of the Copyright Act?

TABLE OF CONTENTS

Page

QUESTION PRESENTED i

INTEREST OF THE *AMICI CURIAE* 1

INTRODUCTION AND SUMMARY OF THE ARGUMENT 1

ARGUMENT 5

I. THE DECISION BELOW ERRONEOUSLY CONCLUDED THAT THE GARMENT DESIGN FEATURES AT ISSUE ARE SOLELY EXPRESSIVE, AND NOT ALSO UTILITARIAN 5

A. Under the Copyright Act, Design Features Can Be Both Expressive and Utilitarian Simultaneously 5

B. The Sixth Circuit Failed to Recognize that Expressive Features Affecting the Way the Wearer Is Perceived Are Also Utilitarian 7

C. "Dual-Nature" Design Features Are Common in Garment Design 18

D. The Arrangement of Stripes, Chevrons, Zigzags, and Color-blocking at Issue Are Both Expressive Features and "Utilitarian Aspects" of the Designs 24

II. GARMENT DESIGN FEATURES THAT ARE SIMULTANEOUSLY EXPRESSIVE AND UTILITIARIAN, SUCH AS THOSE HERE, ARE INHERENTLY INSEPARABLE AND THEREFORE UNPROTECTABLE 29

TABLE OF CONTENTS

Page

CONCLUSION 36

TABLE OF AUTHORITIES

Page(s)

CASES

Baker v. Selden,
101 U.S. 99 (1879) 1, 3, 14

Bleistein v. Donaldson Lithographing Co.,
188 U.S. 239 (1903) 12

Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.,
834 F.2d 1142 (2d Cir. 1987) 31, 35

Brunswick Corp. v. British Seagull Ltd.,
35 F.3d 1527 (Fed. Cir. 1994) 9

DC Comics v. Towle,
989 F. Supp. 2d 948 (C.D. Cal. 2013) 32

Elastic Wonder, Inc. v. Posey,
--- F. Supp. 3d ---, 2016 WL 1451545
(S.D.N.Y. Apr. 12, 2016) 11, 17

Fashion Originators' Guild of Am., Inc. v. Fed. Trade Comm'n,
312 U.S. 457 (1941) 2

Fulmer v. United States,
103 F. Supp. 1021 (Ct. Cl. 1952) 18

Galiano v. Harrah's Operating Co.,
416 F.3d 411 (5th Cir. 2005) 9, 18, 34, 35

Home Legend, LLC v. Mannington Mills, Inc.,
784 F.3d 1404 (11th Cir. 2015) 31

TABLE OF AUTHORITIES

Page(s)

Inhale, Inc. v. Starbuzz Tobacco, Inc.,
755 F.3d 1038 (9th Cir. 2014) 31

Jovani Fashion, Ltd. v. Cinderella Divine, Inc.,
808 F. Supp. 2d 542 (S.D.N.Y. 2011) 16, 17

Jovani Fashion, Ltd. v. Fiesta Fashions,
500 F App'x 42 (2d Cir. 2012) 11, 17

Kieselstein-Cord v. Accessories by Pearl, Inc.,
632 F.2d 989 (2d Cir. 1980) 17, 32

Lego A/S v. Best-Lock Const. Toys, Inc.,
874 F. Supp. 2d 75 (D. Conn. 2012) 32

Mazer v. Stein,
347 U.S. 201 (1954) 1, 19, 31, 32

Nat'l Cloak & Suit Co. v. Std. Mail Order Co.,
191 F. 528 (C.C.S.D.N.Y 1911) 2

Norris Indus., Inc. v. Int'l Tel. & Tel. Corp.,
696 F.2d 918 (11th Cir. 1983) 32, 35

Pivot Poin Int'l, Inc. v. Charlene Prods., Inc.,
372 F.3d 913 (7th Cir. 2004) 32

TABLE OF AUTHORITIES

Page(s)

Progressive Lighting, Inc. v. Lowe's Home Centers, Inc., 549 F. App'x 913 (11th Cir. 2013) (per curiam) 31

Sega Enter. Ltd. v. Accolade, Inc., 977 F.2d 1510 (9th Cir. 1992) 28

Sony Computer Entm't, Inc. v. Connectix Corp., 203 F.3d 596 (9th Cir. 2000) 29

Varsity Brands, Inc. v. Star Athletica, LLC, 799 F.3d 468 (6th Cir. 2015) 7, 10, 13, 30

Whimsicality, Inc. v. Rubie's Costume Co., 891 F.2d 452 (2d Cir. 1989) 16

Zahourek Sys., Inc. v. Balanced Body Univ., LLC, No. 13-cv-01812-RM-CBS, 2016 WL 1377165 (D. Colo. Apr. 7, 2016) 31

STATUTES

17 U.S.C. § 101 ..... *passim*

17 U.S.C. § 102(a)(5) 5

Innovative Design Protection Act of 2012, S. 3523, 112th Cong. (2012) 3

TABLE OF AUTHORITIES

Page(s)

Innovative Design Protection and Piracy Prevention Act, H.R. 2511, 112th Cong. (2011) 3

OTHER AUTHORITIES

2016 Varsity Spirit Fashion Catalog 28

Saliha Aĝaç & Menekşe Sakarya, *Optical Illusions and Effects on Clothing Design*, 3 Int'l J. Sci. Culture & Sport 137 (2015) 20, 21

Christopher J. Buccafusco, *A Theory of Copyright Authorship*, 102 Va. L. Rev. (forthcoming 2016), *available at* http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2664891; 10

MARIAN L. DAVIS, VISUAL DESIGN IN DRESS (3d ed. 1996) ..... *passim*

J. Fan, *Perception of Body Appearance and Its Relation to Clothing*, *in* J. FAN & L. HUNTER, ENGINEERING APPAREL FABRICS AND GARMENTS (2004) 8, 11, 19, 20

J. Fan, *Psychological Comfort of Fabrics and Garments*, *in* J. FAN & L. HUNTER, ENGINEERING APPAREL FABRICS AND GARMENTS (2009) 19, 20, 21, 22

TABLE OF AUTHORITIES

Page(s)

Isla Forsythe, *Subversive Patterning: The Surficial Qualities of Camouflage*, 45 ENV'T & PLANNING 1037 (2013) 13, 16

Jeanne C, Fromer, *An Information Theory of Copyright Law*, 64 Emory L.J. 71 (2014) 10

Jeanne C. Fromer & Mark A. Lemley, *The Audience in Intellectual Property Infringement*, 112 Mich. L. Rev. 1251 (2014) 12

Hugo Gye, *How U.S. Army Spent $5 BILLION on 'Failed' Pixel Camouflage ... Because They 'Wanted To Look Cooler than Marines'*, MAIL ONLINE (June 26, 2012) 9, 16

H.R. Rep. No. 94-1476 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5659 ..... 2, 3

MARILYN J. HORN & LOIS M. GUREL, THE SECOND SKIN (3d ed. 1981) 8, 23

1 *Nimmer on Copyright* § 2.08[B][3] 18

2 *Patry on Copyright* § 3:151 ..... 9, 18

TABLE OF AUTHORITIES

Page(s)

J.H. Reichman, *Design Protection in Domestic and Foreign Copyright Law: From the Berne Revision of 1948 to the Copyright Act of 1976*, 1983 Duke L.J. 1143 ..... 2, 3

MARILYN REVELL DELONG, THE WAY WE LOOK: DRESS AND AESTHETICS (2d ed. 1998) ..... *passim*

Steve Temple, *2014 Corvette C4 Stingray – Like a Knife*, SUPER CHEVY, Oct. 2, 2013 30

INTEREST OF THE *AMICI CURIAE*[1]

Amici are law professors at schools in the United States. They have no personal interest in the outcome of this case. Rather, they have a professional interest in seeing copyright law interpreted with fidelity both to the statute and to the law's Constitutional goal of encouraging, rather than impeding, creativity and innovation. *Amici* are currently drafting a law review article articulating and expanding upon the arguments raised in this brief. The article will be submitted for publication in August 2016. *Amici* are:

Jeanne C. Fromer
Professor of Law
New York University School of Law

Christopher Buccafusco
Professor of Law
Benjamin N. Cardozo School of Law
Yeshiva University

Institutional affiliations are given for identification purposes only.

INTRODUCTION AND SUMMARY OF THE ARGUMENT

Congress and this Court have long expressed concern about the misuse of copyright law to protect functional objects from market competition. *See*

---

[1] Pursuant to Rule 37.6, *amici* affirm that no counsel for a party authored this brief in whole or in part and that no person other than *amici*, their members, and their counsel made a monetary contribution to its preparation or submission. Petitioner's and Respondents' consent to the filing of *amicus* briefs is filed with the Clerk.

Baker v. Selden, 101 U.S. 99, 101-06 (1879); *Mazer v. Stein*, 347 U.S. 201, 217-18 (1954); H.R. Rep. No. 94-1476, at 54-55 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5659, 5667-68; J.H. Reichman, *Design Protection in Domestic and Foreign Copyright Law: From the Berne Revision of 1948 to the Copyright Act of 1976*, 1983 Duke L.J. 1143 (discussing history of American legal protection for design). The fashion industry, in particular, has proven a consistent source of consternation. *See Fashion Originators' Guild of Am., Inc. v. Fed. Trade Comm'n*, 312 U.S. 457 (1941) (deeming efforts to stop garment design piracy a violation of the Sherman Act, and emphasizing that copyright law, as it then existed, did not provide a basis for preventing such piracy). Thus, for more than a century, courts have explained that "a manufacturer of unpatented articles cannot practically monopolize their sale by copyrighting a catalogue containing illustrations of them." *Nat'l Cloak & Suit Co. v. Std. Mail Order Co.*, 191 F. 528, 528 (C.C.S.D.N.Y. 1911).

Consistent with these concerns, the Copyright Act establishes a general rule against copyright protection for useful articles, subject to a narrow exception for expressive features of a useful article that are separable from its functional aspects. *See* 17 U.S.C. § 101. Specifically, the Act provides that "[p]ictorial, graphic, and sculptural works" include "works of artistic craftsmanship insofar as their form *but not their mechanical or utilitarian aspects are concerned.*" *Id.* (emphasis added). Further, "the design of a useful article" is protectable "only if and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be

identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." *Id.* In short, to be protectable a design must exhibit expressive "pictorial, graphic, or sculptural features" (we refer to these as "expressive" features throughout) that are separable from its "utilitarian aspects." *Id.* If a useful article has no expressive features or if the expressive features are inseparable from its utilitarian aspects, it will not receive copyright protection.

Congress was aware that this rule meant many useful works that are visually appealing would be unprotected by copyright, but it considered this appropriate in light of the risks to competition posed by more expansive copyright protection and the availability of design patents for industrial designs. H.R. Rep. No. 94-1476, at 49-50, 54-55, 1976 U.S.C.C.A.N. at 5662-63, 5667-68. Congress concluded that leaving some works with expressive features unprotected by copyright was preferable to allowing functional objects to gain lengthy legal protection while avoiding the high inventive threshold and careful examination of the patent system. *Id.; cf. Baker*, 101 U.S. at 102 ("The claim to an invention or discovery of an art or manufacture must be subjected to the examination of the Patent Office before an exclusive right therein can be obtained . ."). Congress has repeatedly rejected efforts to extend to garment designs precisely the sort of copyright protection that the decision below would provide. *See* Innovative Design Protection Act (IDPA) of 2012, S. 3523, 112th Cong. (2012); Innovative Design Protection and Piracy Prevention Act (IDPPA), H.R. 2511, 112th Cong. (2011); Reichman, *supra*.

To preserve this congressional scheme, it is critical that courts assessing functional works with expressive features recognize the full scope of what is utilitarian. This is particularly true in the context of clothing, where a central purpose of the article is not just to "look good," but to "look good *on* the wearer," that is, to affect how the wearer is perceived. The Sixth Circuit approached this issue incorrectly, by taking a narrow *mechanical* view of the utility of clothing and thereby failing to recognize that the expressive features of clothing designs can simultaneously serve the functional end of affecting how the wearer is perceived. The Copyright Act treats components of garment designs, including two-dimensional shapes, colors, and patterns, that affect the appearance of the wearer's body as utilitarian aspects of the design of a useful article. Where, as here, the exact same design components serve both expressive and utilitarian ends, the expressive and utilitarian aspects of the designs are inherently inseparable and thus unprotectable as a matter of law. The Court should reverse the Sixth Circuit's decision, and clarify the standard for assessing protectability of clothing design features that are both expressive and utilitarian.

ARGUMENT

I. THE DECISION BELOW ERRONEOUSLY CONCLUDED THAT THE GARMENT DESIGN FEATURES AT ISSUE ARE SOLELY EXPRESSIVE, AND NOT ALSO UTILITARIAN

A. Under the Copyright Act, Design Features Can Be Both Expressive and Utilitarian Simultaneously.

The Sixth Circuit correctly recognized that, to determine whether a design for a useful article like clothing is a copyrightable "pictorial, graphic, and sculptural work[]," 17 U.S.C. § 102(a)(5), it is necessary to (1) identify both the work's "pictorial, graphic, or sculptural" (i.e., expressive) features and its "utilitarian aspects," and (2) determine whether the expressive features "can be identified separately from, and are capable of existing independently of" the utilitarian aspects. 17 U.S.C. § 101. The court committed a significant error, however, in failing to recognize that the arrangement of stripes, chevrons, zigzags, and color-blocking in the garment designs at issue here—like many components of clothing designs—had both expressive and utilitarian aspects.

At the most basic level, the court below erred by treating the specific features of Varsity's designs as either strictly expressive or strictly utilitarian. In doing so, the court failed to recognize that the Copyright Act unambiguously provides that components of the design of a useful article may play both expressive and functional roles simultaneously, and it took far too narrow a view of the utilitarian features of clothing.

In order to determine whether a useful article possesses separable expressive design features, a court must first examine the nature of the design components involved. The Copyright Act specifically contemplates that a particular design component can be (1) only "pictorial, graphic, or sculptural," (2) only "utilitarian," or (3) both expressive and utilitarian. On its face, 17 U.S.C. § 101 recognizes this by acknowledging that there are "pictorial, graphic, or sculptural features" that cannot "be identified separately from" the "utilitarian aspects of the article." This language indicates that a component of a design, such as the leg of a chair, may be simultaneously beautiful and functional. The back of an Eames chair is both a brilliant work of visual design and a terrific example of functional ergonomic engineering.

Indeed, the fundamental justification for the useful articles doctrine is to exclude from copyright protection aspects of works that exhibit both expression and function. There would be little need for separability analysis if all components of a design could be designated as either expressive or functional, because copyright law could simply indicate that only the expressive features are protectable. Separability analysis exists precisely because design aspects that are expressive can—and in the case of clothing often will—serve utilitarian purposes.

B. The Sixth Circuit Failed to Recognize that Expressive Features Affecting the Way the Wearer Is Perceived Are Also Utilitarian.

The Sixth Circuit's principal error in this case arose in its identification of the utilitarian aspects of the uniforms' designs (question three in its analysis). In particular, the court's error derived from its unduly narrow—and exclusively mechanical—view of the utilitarian aspects of clothing. The court designated as the uniform designs' "utilitarian aspects" only the uniforms' ability to "cover the body, wick away moisture, and withstand the rigors of athletic movements"—that is, the mechanically or technologically useful aspects of the garments. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 490 (6th Cir. 2015); *cf.* MARIAN L. DAVIS, VISUAL DESIGN IN DRESS 17 (3d ed. 1996) ("All garments must provide for movement and changes in body measurements that come from reaching, stretching, and bending."). Because the patterns of stripes, chevrons, zigzags, and color-blocking did not affect the garment's ability to accomplish cheerleading tasks, the court treated them as solely expressive, non-utilitarian features of Varsity's designs. One could still cheer, flip, and kick with different stripes and chevrons or no stripes and chevrons at all. 799 F.3d at 491 (holding that "[a] plain white cheerleading top and plain white skirt still cover the body and permit the wearer to cheer, jump, kick, and flip").

This was erroneous because the Copyright Act requires treating certain aspects of garment design as serving functional "utilitarian aspects" even if they

are also expressive "pictorial, graphic, or sculptural features" of the design. Designs can have function beyond standard mechanical or technological utility. In particular, the design of a garment is intended *to make the wearer look attractive*. A designer's choices about hemline, neckline, darting, and, often, fabric prints influence people's perceptions of the wearer. As one design expert puts it, garment design is a unique form of visual art because of the "pervading sense of the human qualities present." MARILYN REVELL DELONG, THE WAY WE LOOK: DRESS AND AESTHETICS 134 (2d ed. 1998). A shopper does not simply ask of a garment, "Does it look good?" In addition, and more importantly, he or she asks, "Does it look good *on*?" and "Does it *make me look good*?" *See, e.g.*, J. Fan, *Perception of Body Appearance and Its Relation to Clothing*, *in* J. FAN, W. YU & L. HUNTER, CLOTHING APPEARANCE AND FIT: SCIENCE AND TECHNOLOGY 1 (2004) ("Few people have a perfect body. Most people would like to improve their appearance with appropriate clothing, by camouflaging their less desirable attributes and highlighting the most attractive aspects of their bodies."). In this way, the garment's design is valued for what it can do.

Many features of garment design—line, shape, texture, color, and print—exploit features of human visual perception and optical illusions to influence the way in which the wearer's body is perceived. *See* DAVIS, *supra*, at 21-23, 33; REVELL DELONG, *supra*, at 42, 106-07, 132-33, 166; MARILYN J. HORN & LOIS M. GUREL, THE SECOND SKIN 314 (3d ed. 1981). Importantly, these visual effects can be created with both three-dimensional design techniques such as

garment shape and cut as well as with two-dimensional design techniques such as patterns, stripes, and color. Thus, the frequent assertion that fabric design is non-functional, *see, e.g.*, *Galiano v. Harrah's Operating Co.*, 416 F.3d 411, 419 (5th Cir. 2005), is, in many cases, wrong when the design affects how the wearer is perceived.[2] *Cf. Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527 (Fed. Cir. 1994) (holding that the black color of an outboard engine served the utilitarian purpose of making the engine look smaller, and as a result, was undeserving of trademark protection). Below, we illustrate a number of these techniques, and we show in the next two sections how Varsity's designs incorporate many of them. Before we do, we explain more thoroughly why the Copyright Act explicitly requires this approach.

---

[2] In commenting favorably on the Sixth Circuit's opinion, William Patry supports the notion that two-dimensional designs are non-functional. He asks, "How could it possibly matter whether the design is imprinted on a rug or on a uniform?" 2 *Patry on Copyright* § 3:151. As our examples illustrate, however, the placement of two-dimensional designs on a garment can substantially alter how the wearer is perceived. And we strongly suspect that soldiers on the battlefront care, as a protective matter, whether the particular camouflage they are wearing is well matched to their surroundings. Hugo Gye, *How U.S. Army Spent $5 BILLION on 'Failed' Pixel Camouflage ... Because They 'Wanted To Look Cooler than Marines'*, MAIL ONLINE (June 26, 2012) ("Essentially, the Army designed a universal uniform that universally failed in every environment ...."), http://www.dailymail.co.uk/news/article-2164686/How-U-S-Army-spent-5BILLION-failed-pixel-camouflage--wanted-look-cooler-Marines.html.

The Copyright Act treats aspects of garment design that influence the perception of the wearer's body as "utilitarian features" of a useful article, although they may also be expressive "pictorial, graphic, or sculptural aspects" of the article. The statute defines a useful article as one having "an intrinsic utilitarian function that is *not merely to portray the appearance of the article* or to convey information." 17 U.S.C. § 101 (emphasis added). Thus, the Act distinguishes between articles, or article features, that "merely portray the appearance of the article or ... convey information" and articles, or article features, that have additional utility. By this distinction, aspects of a work that "merely... portray [its] appearance ... or... convey information" are not considered utilitarian features. They are purely expressions of authorship.[3] 799 F.3d at 489. By contrast, aspects of a work that do *not merely* portray its appearance or convey information *are* utilitarian features. The Sixth Circuit ignored this important distinction.

In the context of the useful articles doctrine, the Copyright Act establishes a distinction between

---

[3] The Sixth Circuit treated portraying the appearance of an article and conveying information as utilitarian functions but ones that were not "permitted" to be included in the separability analysis. *See* 799 F.3d at 490. In fact, the Copyright Act establishes that these features of a work are not utilitarian, but expressive "pictorial, graphic, or sculptural features." Conveying information and portraying appearances are characteristic aspects of copyrightable authorship. Christopher J. Buccafusco, *A Theory of Copyright Authorship*, 102 Va. L. Rev. (forthcoming 2016), *available at* http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2664891; Jeanne C. Fromer, *An Information Theory of Copyright Law*, 64 Emory L.J. 71 (2014).

designs or aspects of designs that are valued inherently and those whose value is *dependent on their effect on other objects*. The former it treats as expressive "pictorial, graphic, or sculptural features," and the latter it treats as "utilitarian aspects." Inherently valuable design elements alone may be treated as expressive features of a work. Elements that are dependently valuable for their ability to affect the perception of another object are functional, because they do not exist merely to portray their own appearance. For garments, this dependent visual utility represents an additional way in which aspects of garment design can be utilitarian. In addition to the mechanical utility related to use, warmth, and modesty, garments have additional utility when they entail design features that influence the wearer's appearance. *See Jovani Fashion, Ltd. v. Fiesta Fashions*, 500 F. App'x 42, 44-45 (2d Cir. 2012) (observing that a prom dress can function as such only when it can "cover the body in an attractive way for a special occasion"); *Elastic Wonder, Inc. v. Posey*, --- F. Supp. 3d ----, 2016 WL 1451545, at *8 (S.D.N.Y. Apr. 12, 2016) ("It is the functional purpose of covering the body in an attractive and comfortable way that motivates the designs of fittings of certain shapes, and the utilitarian function of the leggings as clothing is primary over the ornamental aspect."); Fan, *supra*, at 1.

We can imagine a spectrum of visual designs that vary as a matter of inherent versus dependent value. At one end are the designs that are inherently

valuable. They are produced and consumed as such.[4] Fine art paintings and sculptures typically fall at this end of the spectrum, because they are largely produced and consumed for the visual depictions that they provide.[5] At the other end are designs that are primarily dependently valuable. They produce value when brought into appropriate relationships with other objects, and in terms of their effects on those objects: making them look bigger, smaller, different, or better. Camouflage offers an ideal example of designs at this end of the spectrum. The design of a

---

[4] To be sure, whether a garment design feature is expressive, functional, or both can sometimes turn on which audience is surveyed—be it garment designers, consumers of particular garment designs, or fashion critics. *See* HORN, *supra*, at 311 ("[D]esigners impart their individual imprints to the products of their craft and in doing so reveal a part of their nature, their ideals, values, thoughts, and emotions. The product in turn evokes a similar or perhaps a widely different range of feelings and emotions in the observer."); *cf.* Jeanne C. Fromer & Mark A. Lemley, *The Audience in Intellectual Property Infringement*, 112 Mich. L. Rev. 1251 (2014) (maintaining that who decides whether a defendant's product is too similar to a plaintiff's can affect the answer, and that in intellectual property infringement cases, both experts and consumers are the right audiences to be evaluating that similarity).

[5] This is not to say that these are the only reasons why paintings and sculptures are valued. They may also cover holes in walls, match other furniture, or display their owners' taste and wealth. But these are typically secondary considerations for their producers and consumers. *Cf. Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249 (1903) ("[P]ainting and engraving unless for a mechanical end are not among the useful arts, the progress of which Congress is empowered by the Constitution to promote.").

camouflage pattern achieves its value when it is placed in an appropriate environment. When it is, the pattern *works*; it functions to cloak the person or object that it covers.[6] *See, e.g.*, Isla Forsythe, *Subversive Patterning: The Surficial Qualities of Camouflage*, 45 ENV'T & PLANNING 1037 (2013). When a design element alters the way another object appears, that is, when it works in relation to some other object, that design element is utilitarian as a matter of copyright law. Only if a design or an aspect of design exists merely to portray its own appearance should it be treated as purely expressive. *See* 17 U.S.C. § 101 ("A 'useful article' is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a 'useful article.'"). One such example would be an image of a character, such as Mickey Mouse, printed on a t-shirt. The character exists merely to portray its own appearance.

Seen in this light, the Sixth Circuit's concern that recognizing the utility of Varsity's designs would deny protection to a Mondrian painting is misplaced. 799 F.3d at 490. First, unlike the design of a cheerleading uniform, a painting is a "pictorial, graphic, [or] sculptural work," but is not a "useful article," so its copyrightability would never turn on

---

[6] As with the painting, this is not the only value of camouflage. Camouflage is regularly incorporated into items with no intention of masking their appearance. Yet this does not undermine the fact that camouflage is in many cases produced and consumed for the effect it has on objects.

statutory separability analysis. Even if it were subjected to a separability analysis, however, a Mondrian painting merely portrays its own appearance. It was designed and is consumed for its inherent value as a picture. As such it has little, if any, utilitarian function within the meaning of the statute. Consider, however, trompe l'œil design techniques, which can be used to make a room look bigger. As depicted in Figure 1, the components of a design that trick the eye into thinking that the ceilings are higher than they are should not be treated like the Mondrian painting because they are not valuable in their own right. Aspects of the design that produced such a visual effect, such as the use of foreshortening and a vanishing point, are properly treated as utilitarian. As this Court long ago recognized in *Baker v. Selden*, "A treatise on...the mode of drawing lines to produce the effect of perspective...would be the subject of copyright; but no one would contend that the copyright of the treatise would give the exclusive right to the art or manufacture described therein." 101 U.S. at 102.

Figure 1: **Andrea Pozzo, Fresco with Trompe L'Oeil Dome Painted on Low Vaulting, Jesuit Church, Vienna, Austria (1703)**

Components of garment design that influence the wearer's appearance do not "merely... portray the appearance" of the garment. They also affect the appearance of the person wearing the garment. To the extent that aspects of garment design affect the way in which the wearer is perceived, they are utilitarian. This can include the cut, fit, and drape of a garment, as well as two- or three-dimensional aspects of the design that direct attention toward or

away from parts of the wearer's body or that otherwise influence how he or she is viewed. For example, a camouflage-patterned garment will both display camouflage as a "pictorial" or "graphic" matter and cloak its wearer from observation by others when worn against a background with which the camouflage blends or coordinates. *See* Forsythe, *supra*; Gye, *supra*. The Copyright Act requires that these components of the design be treated as "utilitarian aspects" of the work for purposes of separability, even if they may also be categorized as "pictorial, graphic, or sculptural features."

This is, we think, the point that courts in the Second Circuit have made in a line of cases—disagreed with by the Sixth Circuit—identifying a utilitarian "decorative function" in garment design. For example, in *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452 (2d Cir. 1989), a case concerning the copyrightability of various costume designs, the Second Circuit explained that while conceptually separable features of garment designs could, in theory, receive copyright protection, most aspects of garment design would not meet this standard because "the very decorative elements that stand out [are] intrinsic to the decorative function of the clothing." *Id.* at 455. That is, the particular features of the garment for which the designer claims protection are likely also to be ones that affect how the wearer is perceived.

Similarly, in *Jovani Fashion, Ltd. v. Cinderella Divine, Inc.*, 808 F. Supp. 2d 542 (S.D.N.Y. 2011), the Southern District of New York explained that the sequins and crystals on the bodice of the prom dress at issue, the horizontally ruched-satin fabric on the

waistband, and the layers of tulle in the skirt were "plainly fashioned to fit the specific needs of a prom dress." *Id.* at 550. These aspects of the prom dress, while attractive on their own, also contributed to the dress's "utilitarian function of enhancing the wearer's attractiveness." *Id.* The Second Circuit, upholding the judgment, agreed, emphasizing that these garment features are not separable "pictorial, graphic, or sculptural features" because "the [physical or conceptual] removal of these items would certainly adversely affect the garment's ability to function as a prom dress, a garment specifically meant to cover the body in an attractive way for a special occasion." *Jovani Fashion*, 500 F. App'x at 44-45; *cf. Elastic Wonder*, 2016 WL 1451545, at *8 ("It is the functional purpose of covering the body in an attractive and comfortable way that motivates the designs of fittings of certain shapes, and the utilitarian function of the leggings as clothing is primary over the ornamental aspect."); *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980) (recognizing that the belt buckles at issue "include decorative features that serve an aesthetic as well as a utilitarian purpose").

These opinions correctly recognize that garments do not typically exist merely to look attractive in their own right but also to make those who wear them look attractive. This "decorative function" is one we think is better referred to as having "dependent value," by which we mean value dependent on use in relation to another object, or more colloquially, "looking good *on*." Moreover, these opinions treat aspects of garment design that affect how the wearer looks as appropriately placed on the "utilitarian aspects" side of the expressive/functional ledger when

determining conceptual separability, even if they may also fall on the other side as "pictorial, graphic, or sculptural features." Indeed, many features of garment design will have a dual nature. They will be both expressive features and simultaneously utilitarian aspects of the garment. This is consistent with the definition of "useful articles" in section 101, which recognizes that design features may perform both expressive and functional roles.

C. "Dual-Nature" Design Features Are Common in Garment Design.

As all shoppers know, a certain style or cut of a garment may look good on one person but not on another. And different sorts of designs may affect how people's bodies look. This is not accidental. Design choices create visual effects that can vary the size of the wearer's body or body parts. In this section, we illustrate a number of these techniques before we demonstrate in the next section how these techniques were used in Varsity's uniform designs.

To begin, it is important to note that these techniques include both three-dimensional design choices involving the shape and cut of garments as well as two-dimensional design choices involving shapes, colors, and patterns. This is essential because courts and scholars have often reflexively treated two-dimensional fabric designs as non-functional. *Galiano*, 416 F.3d at 419; 1 *Nimmer on Copyright* § 2.08[B][3]; 2 *Patry on Copyright* § 3:151. Yet both two- and three-dimensional design features will often be utilitarian in nature. As discussed above, camouflage offers an obvious example of a functional two-dimensional pattern. *Cf. Fulmer v. United States*,

103 F. Supp. 1021 (Ct. Cl. 1952) (finding no copyright infringement when the U.S. government produced camouflage parachutes from the plaintiff's design showing top and side views of a similar parachute because finding otherwise would be akin to conferring unwarranted patent protection) (cited in *Mazer*, 347 U.S. at 217 n.39). The techniques discussed below work in similar ways, by altering how the viewer sees the clothed person.

Further, the Copyright Act clearly anticipates that two-dimensional designs can be functional when it refers to "pictorial, graphic, or sculptural features" that are inseparable from utilitarian aspects of the design. 17 U.S.C. § 101. The first two objects in this list, pictorial and graphic features, are, in fact, two-dimensional design techniques. The statutory scheme thus makes clear that two-dimensional works and features, and not only three-dimensional works and features, can be utilitarian. By stating that "pictorial, graphic, or sculptural work[s]" can be "useful articles," rather than limiting the statutory text to "sculptural works," *id.*, it is apparent that Congress recognized that both two- and three-dimensional works can be utilitarian. Similarly, by indicating that "pictorial, graphic, or sculptural features" might be inseparable from "utilitarian aspects" of the design, rather than just referring to "sculptural features," *id.*, the copyright statute signifies that both two- and three-dimensional features can be utilitarian.

As even casual shoppers know, the placement of horizontal lines on a garment can make the wearer look shorter and broader, while vertical lines have the opposite effect of lengthening the wearer's body. *See* DAVIS, *supra*, at 36-41; Fan, *Perception of Body*

Appearance, *supra*, at 11; J. Fan, *Psychological Comfort of Fabrics and Garments*, *in* J. FAN & L. HUNTER, ENGINEERING APPAREL FABRICS AND GARMENTS 251, 257 tbl. 9.1 (2009). Garment design can visually minimize the size of body parts judged to be too large by either appearing to subdivide those body parts or by counterbalancing them to increase the size of surrounding parts. *See* Fan, *Perception of Body Appearance*, *supra*, at 11. A V-shaped neckline can make the neck look longer and narrower while also making shoulder width narrower. DAVIS, *supra*, at 339. A bodice can be smocked, pleated, draped, or gathered at the bust to make the bust appear larger. *Id.* at 340.

Designers can also affect the perception of the shape of body parts through design choices. Importantly for our purposes, the combination of colors, shapes, and lines can have enormous influence on how the wearer's body is perceived. This is known as color-blocking, and it was recently made famous by Stella McCartney's line of dresses, garment designs employing a color-blocked hourglass appearance that made wearers' bodies look both curvier and slimmer. Two examples of these dresses, as worn by actress Kate Winslet, are shown in Figure 2. The black color along the sides, which changes in width at various points, produces a particularly striking hourglass shape. And, in the dress on the right, the brighter color on the top of the dress produces a larger and more defined bust. *See* Saliha Ağaç & Menekşe Sakarya, *Optical Illusions and Effects on Clothing Design*, 3 Int'l J. Sci. Culture & Sport 137, 154-55 (2015). Similarly, as one design textbook indicates, "A line continuing around the body, diagonal stripes

that are not too dominant, or a reflecting surface smoothly contouring the body call our attention to the rounded contours." REVELL DELONG, *supra*, at 117.

Figure 2: **Fiona Raisbeck, Kate Winslet** Wows in Another Body-Con Stella McCartney Dress, MARIE CLAIRE (Nov. 21, 2011), http://www.marieclaire.co.uk/news/fashion/532781/kate-winslet-wows-in-another-body-con-stella-mccartney-dress.html#index=1

Optical illusions can also be deployed in garment design to influence perceptions of the wearer's body. *See generally* DAVIS, *supra*, at 40-50; Aĝaç, *supra*, at 137 (cataloguing various illusions to be used). Consider the Müller-Lyer illusion, as shown in Figure 3, which causes a line to look longer if it is bracketed on each end by arrow tails and shorter if it is bracketed on each end by arrow heads. *See* Fan, *Psychological Comfort*, *supra*, at 257. This illusion can be incorporated into garment design to lengthen

or contract the body of the wearer through placement of arrow heads or tails, as shown in Figure 4. *See* DAVIS, *supra*, at 40; Fan, *Psychological Comfort*, *supra*, at 257.

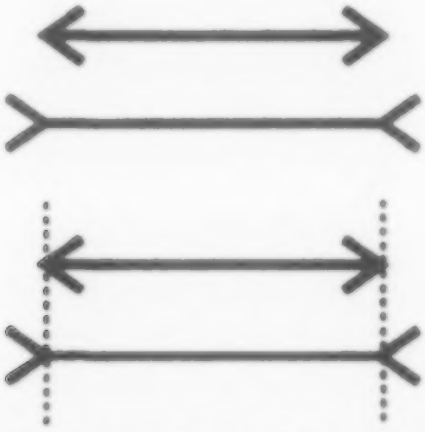


Figure 3: Patric Nordbeck, An Ecological Note on the Müller-Lyer Illusion, PSYPHI > SCIFI (Feb. 22, 2015), http://pnpsyphi.blogspot.co.uk/2015/02/an-ecological-note-on-muller-lyer.html

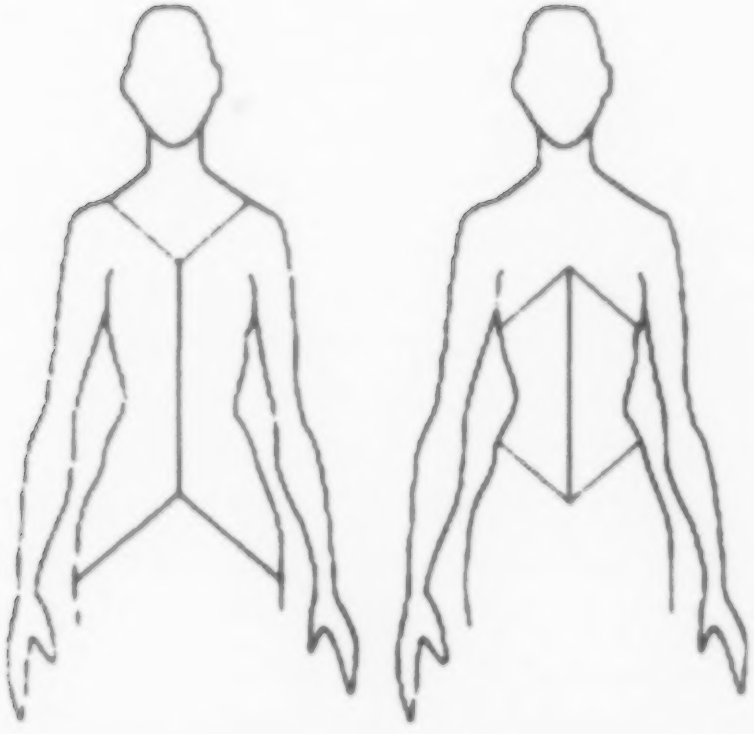


Figure 4: Aĝaç & Sakarya, *supra*, at 143 fig. 1.e.

To emphasize, or draw attention to, a particular body part, a garment design can include a dominant design element over the body part that it covers when the associated garment is worn. DAVIS, *supra*, at 26; HORN & GUREL, *supra*, at 320-21. As two design experts explain more generally, "emphasis can be achieved through strong contrasts in value, but the contrast can also come about through bright intensities of color, unusual shapes, the use of different textures, a boldness of size, or a juxtaposition of contrasting lines." HORN & GUREL, *supra*, at 321. Shapes are good candidates for producing emphasis, especially when large, bold, and contrasted with their surroundings. *See* REVELL DELONG, *supra*, at 183-84, 189, 244. Triangular shapes or folds in garment design can create visual

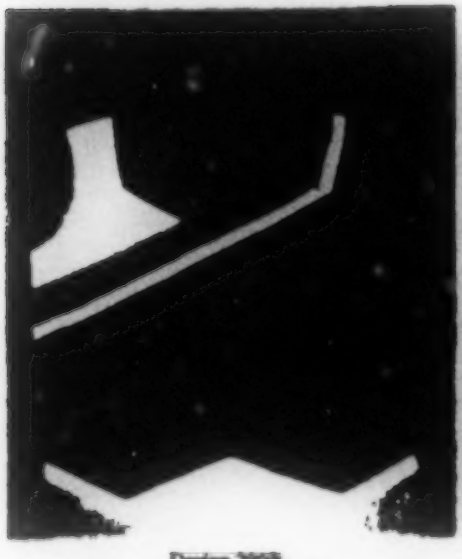
emphasis by appearing to converge and point at the part of the body covered by these shapes. *See id.* at 244. The center front area of the body is often chosen for emphasis, drawing attention there and reducing the effect of the volume of the entire body. *See id.* at 124 (illustrating this effect with the use of Korean traditional dress).

D. The Arrangement of Stripes, Chevrons, Zigzags, and Color-blocking at Issue Are Both Expressive Features and "Utilitarian Aspects" of the Designs.

The stripes, chevrons, and color-blocking in Varsity's claimed designs, as shown in Figures 5 and 6, serve a purpose similar to those documented above. They are simultaneously both expressive and functional, serving to accentuate and elongate the cheerleader's body and make it appear curvier in particular areas. Herein, we detail some of these dual-nature features in light of the discussion above.

Design 077I
Registration No. VA 1-417-427

Design 081S
Registration No. VA 1-673-905



Design 299B
Registration No. VA 1-319-226

Design 299A
Registration No. VA 1-319-228

Figure 5: Varsity's claimed designs

Design 074
Registration No. VA 1-411-535

Figure 6: Varsity's Claimed Designs

In Design 078, the white patches in the color-blocked pattern help create the visual effect of curviness by creating an hourglass shape with contrast, as in Stella McCartney's dresses. The V-shaped neckline together with the inverted-V-shaped slit on the skirt elongates the body by exploiting the Müller-Lyer illusion. The V-shaped neckline also serves to point to the bust and elongate the neck. The

color-blocking, using contrasting colors, creates contrast and draws attention to the wearer's body. The repeating stripe pattern at the neckline, bust, waist, and skirt hem draws viewers' attention from the top of the wearer's neckline all the way to the bottom of the wearer's skirt to see that part of the wearer's body as unified. *See* REVELL DELONG, *supra*, at 229 ("Direction can be aided by repetition of similar parts, often called rhythm. Rhythm is defined as the ordered recurrence of parts that leads the eye.").

Again in Design 0815, Varsity employs color-blocking, this time a darker blue color, along the side of the uniform to make the wearer look both more slender in certain places and curvier in others, just as in the Stella McCartney dresses. In addition, the V-shaped striping on the front center of the uniform design serves to further accentuate the bust. The V-shaped neckline both points to the bust and elongates the neck.

Designs 299A and 299B have some of the same features associated with the previous two designs, plus there is a diagonal striping, which calls attention to the body's rounded contours. Additionally, the chevron at the bottom of the uniform top is cut to display some of the belly and draw attention to it.

Design 074 serves to accentuate the curves and elongate the body for many of the reasons discussed with regard to the previous designs. In addition, the color-blocking serves to highlight the bust by coloring it in white in contrast to the green above it and navy blue below it.

The stripes, chevrons, and color-blocking that form the heart of Varsity's uniform designs do not merely portray their own appearance. They also influence the appearance of the uniform's wearer. These features are the reason that the designs work as appropriate designs for garments meant to emphasize the fitness, athleticism, and attractiveness of those who don them.[7] It is no accident that Varsity has chosen to design its uniforms in this fashion, and it is no accident that many cheerleading uniforms share similar design features.[8] Granting copyright protection for these designs would enable Varsity to monopolize functional aspects of garments without satisfying the exacting demands of patent law. Although other designers might be free to produce cheerleading uniforms incorporating features that flatten the bust, widen the waist, and shorten the legs, we suspect that they are unlikely to find a vibrant market for such products. This is not the sort of competitive advantage that copyright law is intended to foster. *See Sega Enter. Ltd. v. Accolade,*

---

[7] This is a different claim from the one made by Judge McKeague in his dissenting opinion below. We are not claiming that the design features perform a signifying function to identify the wearers as cheerleaders. We argue that these design features are functional because they were designed to influence how the wearers' bodies were perceived.

[8] It is also no accident that Varsity's designs for male cheerleaders often have different design elements from those for female cheerleaders, because the physical aspects of male and female bodies that are emphasized differ. *See* 2016 Varsity Spirit Fashion Catalog 82 available at www.varsity.com/publications/Varsity-Spirit-Fashion-2016.html#82.

Inc., 977 F.2d 1510, 1523-24 (9th Cir. 1992) ("[A]n attempt to monopolize the market by making it impossible for others to compete runs counter to the statutory purpose of promoting creative expression ...."); *Sony Computer Entm't, Inc. v. Connectix Corp.*, 203 F.3d 596, 607 (9th Cir. 2000) ("Sony understandably seeks control over the market for devices that play games Sony produces or licenses. The copyright law, however, does not confer such a monopoly.").

II. GARMENT DESIGN FEATURES THAT ARE SIMULTANEOUSLY EXPRESSIVE AND UTILITIARIAN, SUCH AS THOSE HERE, ARE INHERENTLY INSEPARABLE AND THEREFORE UNPROTECTABLE

The stripes, chevrons, and color-blocking on Varsity's uniform designs are visually appealing graphic features of the uniforms' designs. In addition, these same features are also utilitarian aspects of the designs that enhance the perception of the wearer's body. Because the Sixth Circuit failed to recognize this duality in its analysis, the decision below should be reversed. Importantly, this is true regardless of the test for separability that applies to the garments. The stripes, chevrons, and color-blocking cannot be treated as physically or conceptually separable under any recognized test for separability, because the same design aspects play both expressive and functional roles simultaneously.

As we discussed above, as a general rule the design of a useful article is not protectable under copyright law. Rather, the Copyright Act carves out a limited class of pictorial, graphic, and sculptural features of

useful articles that may obtain protection "only if and only to the extent" that they "can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. § 101. This exception to the rule allows for certain purely expressive features to receive protection even though they are incorporated into a useful article, such as a scrollwork design on a chair.

This exception underlies the separability doctrine, which asks both whether the expressive features of the work can be identified separately from its functional aspects and whether the expressive features can exist independently of the functional aspects. *Id.*; 799 F.3d at 491-93. Where, however, the components of a design that are claimed as the expressive pictorial, graphic, or sculptural features also, simultaneously, function as utilitarian aspects of the article they could never maintain separable identification and existence. When a claimed aspect of a design is both visually appealing and *at the same time* utilitarian it makes no sense to say that the visually appealing nature of the aspect "can be identified separately from, and [be] capable of existing independently of" the functional nature of the aspect. The curve of the hood of a Corvette Stingray both makes the car look beautiful and affects its aerodynamics. *See* Steve Temple, *2014 Corvette C4 Stingray – Like a Knife*, SUPER CHEVY, Oct. 2, 2013, http://www.superchevy.com/features/1309-2014-corvette-c7-stingray-like-a-knife. In drafting the useful articles doctrine, Congress rejected copyright protection for these sorts of dual-nature designs.

In the myriad of cases involving separability, we have not located any court decision—neither by this Court, nor by any other federal court—that has expressly found an element of a useful article to possess this dual nature and also to be separable and therefore copyrightable. *See, e.g.*, *Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 755 F.3d 1038 (9th Cir. 2014) (holding that the distinctive shape of a hookah water container is also functional and therefore not separable); *Progressive Lighting, Inc. v. Lowe's Home Centers, Inc.*, 549 F. App'x 913, 921 (11th Cir. 2013) (per curiam) (finding all components of a light fixture to be uncopyrightable because "the expressive aspects of the light fixtures are also functional components of the utilitarian articles"); *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1147 (2d Cir. 1987) (holding that "the form of the rack is influenced in significant measure by utilitarian concerns and thus any aesthetic elements cannot be said to be conceptually separable from the utilitarian elements"); *Zahourek Sys., Inc. v. Balanced Body Univ., LLC*, No. 13-cv-01812-RM-CBS, 2016 WL 1377165 (D. Colo. Apr. 7, 2016) (holding that a lifelike model of a human skeleton designed to teach anatomy is functional and that any expressive features are not separable).[9] As the Eleventh Circuit

---

[9] There are, by contrast, many cases in which courts hold that a feature of a useful article is expressive, but not functional, and also separable (and therefore copyrightable). *See, e.g.*, *Mazer*, 347 U.S. 201 (holding the expressive dancer statuette to be separable from the functional lamp); *Home Legend, LLC v. Mannington Mills, Inc.*, 784 F.3d 1404 (11th Cir. 2015) (holding that a decorative layer featuring two-dimensional artwork between a core board and a transparent overlay in laminate

has explained, "functional components of useful articles, no matter how artistically designed, have generally been denied copyright protection" as inseparable. *Norris Indus., Inc. v. Int'l Tel. & Tel. Corp.*, 696 F.2d 918, 924 (11th Cir. 1983) (listing physically separable elements, however, as an exception). If these dual-nature elements of useful articles receive protection, it must be through the design or utility patent regimes.

The claimed features of Varsity's cheerleading uniform designs are perfect examples of dual-nature features. As explained in the previous section, the

---

(continued...)

wood flooring is expressive, separable, and copyrightable); *Pivot Poin Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913 (7th Cir. 2004) (determining that specific facial features on a mannequin used as a hair stand and makeup model are expressive, and not functional, choices and are therefore separable and copyrightable); *Kieselstein-Cord*, 632 F.2d 989 (holding that the expressive, non-functional ornamentation on belt buckles is conceptually separable from the functional aspects of the belt buckle); *DC Comics v. Towle*, 989 F. Supp. 2d 948, 970 (C.D. Cal. 2013) ("[T]he *design elements* of the two Batmobiles at issue here are conceptually separable from their underlying car. In particular, the 1989 Batmobile's entire frame, consisting of the rear exaggerated, sculpted bat-fin and the mandibular front, is an artistic feature that can stand on its own without the underlying vehicle. The underlying vehicle would still be a car without the exaggerated bat features."); *Lego A/S v. Best-Lock Const. Toys, Inc.*, 874 F. Supp. 2d 75, 99 (D. Conn. 2012) ("If the [Lego] minifigures' capacity to attach to other toys is functional, while their capacity to inspire imagination or play are not, then the drawings on the face and torso are clearly conceptually separable ....").

arrangement of stripes, chevrons, zigzags, and color-blocking that make up the expressive features of Varsity's designs also serve a functional purpose: to influence how the wearer's body is perceived. The particular design features of Varsity's uniforms do not exist merely to portray their own appearance. They are not merely ornamental or arbitrarily determined in the way that a graphic of a cartoon character printed on a shirt is. They are placed where they are because of the nature of the human bodies that will wear them. The shapes, sizes, and colors of the design features look the way they do because these particular shapes, sizes, and colors will interact with wearers' bodies in particular ways. While they might be aesthetically pleasing or attractive in their own right, they also affect the actual perception of the wearers' bodies as aesthetically pleasing or attractive.

One can appreciate the futility of Varsity's claim when one tries to imagine the aspects of their designs to which copyright might attach. As the Copyright Act explains, copyright protection for a useful article extends only "to the extent" of the separable expressive features of the design. 17 U.S.C. § 101. Thus, while the separable expressive features may receive protection, copyright will never cover the utilitarian aspects of the design.[10] Here, Varsity claims protection for the particular placement, size, color, and shape of the stripes, chevrons, and color-blocking of its uniforms. But it is just those features

---

[10] These will always remain free to copy unless protected by another intellectual property regime, such as patent law.

of the design that also simultaneously produce the uniforms' functional effects. As a matter of logic, the Copyright Act cannot both protect the expressive features of the uniforms and preserve from protection their functional aspects when those expressive features and functional aspects are one and the same.

Thus, a proper analysis of the third question that the Sixth Circuit posed about identifying the expressive features and the utilitarian aspects of cheerleading uniforms will, in this case, determine the only appropriate answer to the final questions: whether the expressive features of the works are separable from and can exist independently of their utilitarian aspects. When the same aspects of the designs are simultaneously expressive and functional, neither the Sixth Circuit nor this Court need inquire further into their separability. The expressive and functional aspects are inherently inseparable, and thus the designs are unprotectable as a matter of law. The courts need not wade into the murky waters of the numerous and overlapping separability tests when confronted with design features that are both expressive and functional.[11]

---

[11] It is likely because many garment features are either fully functional or both simultaneously expressive and functional that the Fifth Circuit has observed both that "clothing designs rarely pass the 'separability' test" and that other courts "sometimes appear to implement a categorical approach" denying "copyright protection per se" to garment designs. *Galiano*, 416 F.3d at 419 n.17 (citing 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 2.08[B][3], at 2-101). Although we do not advocate a categorical rule, we believe that a presumption of utility is appropriately applied to garment design.

Should this Court deem such an inquiry necessary, however, it is apparent that the case should still be remanded in light of the Sixth Circuit's incorrect analysis of the third question (as to which features are expressive and which are functional), as discussed above. The third question must be answered correctly before any inquiry into whether the features are separable.

Courts and scholars have proposed numerous tests for determining whether the expressive features of a design are separable from its utilitarian aspects. *See, e.g., Norris Indus.*, 696 F.2d 918 (holding that tire covers without "superfluous sculptural design" are not copyrightable); *Brandir, Int'l*, 834 F.2d 1142 (holding the copyrightability is limited by the extent to which the design process involved artistic expression uninhibited by functional considerations); *Galiano*, 416 F.3d at 420 (holding that the copyrightability of a useful article turns on the capacity of the item to "moonlight as a piece of marketable artwork"). All of these tests, however, require an accurate analysis of which are which. As we have shown, the Sixth Circuit's analysis of this point was mistaken. Thus, whether this Court adopts the Sixth Circuit's approach to determining separability or whether it chooses a different test, it must ensure that the different aspects of Varsity's designs are appropriately identified. Here, the stripes, chevrons, zigzags, and color-blocking should be treated as *both* expressive features and utilitarian aspects of the designs.

CONCLUSION

Varsity's cheerleader uniform designs, however expressive they might be, should not receive copyright protection because they are also utilitarian. Both the Copyright Act and this Court have long recognized the dangers of allowing creators to use the copyright system to receive protection for utilitarian features of their works. Functionality is more properly channeled to the design or utility patent systems, with their higher protectability thresholds, searching examination, and shorter duration. This was Congress's intention when it drafted the Copyright Act of 1976, and it is the best way to preserve copyright law's mandate of promoting the progress of science and the useful arts. The decision below should be reversed.

Respectfully submitted,

JEANNE C. FROMER
NEW YORK UNIVERSITY
SCHOOL OF LAW
40 Washington Square
South
New York, NY 10012

CHRISTOPHER BUCCAFUSCO
BENJAMIN N. CARDOZO
SCHOOL OF LAW
YESHIVA UNIVERSITY
55 Fifth Avenue
New York, NY 10003

MEIR FEDER
Counsel of Record
MATTHEW J. SILVEIRA
JONES DAY
250 Vesey Street
New York, NY 10281
(212) 326-3939
mfeder@jonesday.com

July 22, 2016

Counsel for Amici Curiae